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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/046,095      | 01/16/2002  | Masaru Deguchi       | Q68077              | 2414             |

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EXAMINER

NGUYEN, PHUONGCHI T

ART UNIT PAPER NUMBER

2833

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/046,095

Applicant(s)

DEGUCHI, MASARU

Examiner

Phuongchi T Nguyen

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1- 13 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. The specification and Claims 1-13 are objected to because of the following informalities:  
  
Throughout the application, "earth" should be changed to -- ground --.  
  
Appropriate corrections are required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 1-6, 8-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by  
  
Hirzmann (US6535394B1).

In regard to claim 1, Hirzmann discloses (figure 3) an earth connection structure (Hirzmann's apparatus has the same basic structure as applicant's earth connection; thus Hirzmann's apparatus carries the same function as Applicant's earth connection) comprising a substrate (100), on whose surface earth/ground is formed; an earth/ground connecting member (300, 320, 310) which is connected to the earth/ground; and a compensating member (110) which compensates for an area of the earth/ground and is joined to the substrate (100) such that the earth connecting member (300, 320, 310) is sandwiched between the compensating member (110) and the substrate (100), and wherein the earth connecting member (300, 320, 310) has elasticity, contacts the compensating member (110) by being sandwiched between the substrate

(100) and the compensating member (110), and electrically connects the earth/ground with the compensating member (110) in a low impedance state.

In regard to claims 2 and 8, Hirzmann discloses (figure 3) the earth-connecting member (300, 320, 310) wherein a base (300) connected to the earth; and an elastic spacer (320) arranged on the base (300).

In regard to claim 3, Hirzmann discloses (figure 3) the earth connection structure wherein the substrate (100) has at least one through-hole (where 310 going through) for fixing the earth connecting member (300, 310, 320) on the substrate (100); and the base (300) includes at least one lead (310), which is inserted into the at least one through hole (where 310 going through on 100) and connected to the earth/ground.

In regard to claim 4 and 9, Hirzmann discloses (figure 3) the earth connection structure wherein the at least one lead (310) has elasticity and a protruding portion (thread of screw 310) for fixing the earth connecting member (300, 310, 320) onto the substrate (100).

In regard to claims 5 and 10, Hirzmann discloses (figure 3) the earth connection structure wherein the base (300) has at least one lead (310) having a margin, left (surface on 310) for being connected to the earth and formed in parallel with surface (along the through hole inside 100) of the earth.

In regard to claims 6 and 11, Hirzmann discloses (figure 3) the earth connection structure wherein the spacer (320) includes a plate spring.

In regard to claim 13, Hirzmann discloses (figure 3) an earth connection method comprising connecting an earth connecting member (300, 310, 320) having elasticity and conductivity, to earth formed on a substrate (100); and arranging a compensating member (110)

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for compensating for an area of the earth, on the substrate (100) such that the earth connecting member (300, 310, 320) is sandwiched between the compensating member (110) and the substrate (100), thereby electrically connecting the earth and the compensating member (110) via the earth connecting member (300, 310, 320) in a low impedance state.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 12 is rejected under 35 U.S.C. 103(a) as being obvious over Hirzmann (US6535394B1).

In regard to claim 7 and 12, Hirzmann discloses the invention, but lacks a spacer to be a coil spring. It would have been obvious to one having ordinary skill at the time the invention was made to modify the plate spring spacer of Hirzmann with a coil spring; since the examiner Takes Official Notice of the equivalence of the plate spring for their use in the earth connection structure art and the selection of any of these known equivalents to the coil spring would be within the level of ordinary skill in the art.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchi T Nguyen whose telephone number is (703) 305-0729. The examiner can normally be reached on Monday through Thursday from 8:00AM to 4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (703) 308 - 2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7723 for regular communications and (703) 305-7723 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3329.

April 30, 2003

  
P. AUSTIN BRADLEY  
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